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In re Application of :
CHEN et al. :
Application No.: 10/563,729 : DECISION ON
PCT No.: PCT/CN2004/000756 :
Int. Filing Date: 06 July 2004 : PETITION UNDER
Priority Date: 08 July 2003 :
Attorney Docket No.: 1322-001 : 37 CFR 1.137(b)
For: SPECTACLES FOR CORRECTING :
COLOR BLINDNESS :
:

This decision is in response to applicants' submission filed 21 December 2007 which includes, *inter alia*, a petition under 37 CFR 1.137(b).

BACKGROUND

On 06 July 2004, applicant filed international application PCT/CN2004/000756 which designated the U.S. and claimed a priority date of 08 July 2003. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 13 January 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 09 January 2006 (08 January 2006 being a Sunday).

On 06 January 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the Basic National Fee and a purported English translation of the international application.

On 10 April 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b), the surcharge under 37 CFR 1.492(h), a translation of the international application into English, and the processing fee under 37 CFR 1.492(i) were required. The NOTIFICATION set a two-month extendable period for response.

On 10 July 2006, applicants filed an executed declaration of inventors, a purported translation of the international application into English, the surcharge under 37 CFR 1.492(h),

and a petition/fee for a one-month extension of time.

On 27 December 2006, the DO/EO/US mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating, *inter alia*, that the response filed 10 July 2006 was acknowledged but that the requirements set forth in the NOTIFICATION OF MISSING REQUIREMENTS mailed 10 April 2006 had not been met. Specifically, it was indicated that the declaration was not in compliance with 37 CFR 1.497(a)-(b) because three inventors are listed in the declaration while only two inventors are listed in the published international application and that the processing fee under 37 CFR 1.492(i) was not provided. This NOTIFICATION set a time limit of ONE MONTH from the date of this Notification or within the time remaining in the response set forth in the NOTIFICATION OF MISSING REQUIREMENTS mailed 10 April 2006, whichever was longer. This Notification also noted that no extension of this time limit may be granted under 37 CFR 1.136, but that the period for response set in the NOTIFICATION OF MISSING REQUIREMENTS mailed 10 April 2006 may be extended under 37 CFR 1.136(a).

On 17 April 2007, the DO/EO/US mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned as to the United States of America for failure to respond to the NOTIFICATION OF MISSING REQUIREMENTS.

On 21 December 2007, applicants filed the instant submission which includes a petition under 37 CFR 1.137(b).

DISCUSSION

Purported English Translation of International Application

An English translation of the international application as filed has not yet been submitted. -The submission filed 06 January 2006 included two documents in English. One appears to be a proposed substitute specification (attention is directed to 37 CFR 1.125 for the proper requirements for filing a substitute specification). The other appears to be a translation of the published priority document CN03127614.8 filed 08 July 2003. -The submission filed 10 July 2006 included a second copy of what appears to be a translation of the published priority document CN03127614.8 filed 08 July 2003.

A translation of “the international application, as filed, into the English language” is required. See, e.g., 37 CFR 1.495. This has not yet been provided.

Inventorship

37 CFR 1.41(a)(4) states:

The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any change effected under PCT Rule 92bis. See § 1.497(d) and (f) for filing an oath or declaration naming an inventive

entity different from the inventive entity named in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any declaration filed under PCT Rule 4.17(iv) (§ 1.48(f)(1) does not apply to an international application entering the national stage under 35 U.S.C. 371).

The declaration filed 10 July 2006 listed three inventors while the international application listed only two inventors. A Form PCT/IB/306 (NOTIFICATION OF THE RECORDING OF A CHANGE) from the International Bureau indicating that an inventor has been added does not appear in the file. Accordingly, the NOTIFICATION OF DEFECTIVE RESPONSE was mailed indicating this discrepancy.

In the submission filed 21 December 2007, applicants provide a statement from the additional inventor stating that there was no deceptive intention on his part in being incorrectly named "as an inventor of the color blindness correcting lens application." However, this third inventor is not listed anywhere in the application file as an inventor. Thus, there is no need for a statement from him.

The declaration of inventors filed 21 December 2007 is in compliance with 37 CFR 1.497(a)-(b).

Petition Under 37 CFR 1.137(b)

A petition to revive the present application under 37 CFR 1.137(b) must include:

- (1) The required reply;
- (2) The petition fee;
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

Item (1) has been satisfied. A declaration of inventors in compliance with 37 CFR 1.497(a)-(b) has been provided.

As to item (2), applicant submitted the petition fee on 21 December 2007.

As to item (3), the required statement has been provided.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.137(b) is GRANTED.

Applicants are required to file an English translation of the international application as

filed and the processing fee under 37 CFR 1.492(i) within TWO (2) MONTHS from the date of mailing of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper reply will result in abandonment of the application.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

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